REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed April 22, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(e)

Claims 1, 4, 7-9, 12, 14, and 18-24 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Morcos, et al. ("Morcos," U.S. Pat. No. 6,384,849). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the Morcos reference. Applicant discusses the Morcos reference and Applicant's claims in the following.

A. The Morcos Disclosure

Morcos discloses a method for displaying controls in a system. Morcos, Patent Title. More particularly, Morcos discloses a method for merging menu items in a user application. Morcos, entire disclosure.

In the Background section of the disclosure, Morcos discusses the advantages of merging menu items from two different user applications. Morcos, column 2, lines 55-65. There, Morcos states the following:

For example, a Microsoft Excel spreadsheet (the object) may be embedded and displayed in a Microsoft Word document (the container). When the embedded object is activated, it may be edited. In order to facilitate this process, Microsoft's Object Linking and Embedding (OLE)) interface merges the menus from the spreadsheet and word processing programs, thereby providing relevant commands to the user. [Morcos, column 2, lines 58-65]

Morcos' disclosed invention achieves the same ends, but merges the menus in what Morcos calls a "command bar." Morcos, column 7, lines 35-59. Morcos describes this process in greater detail under the heading "Command Bar Merging." There, Morcos states the following:

> As mentioned above, Microsoft Corporation's OLE interface allows documents of one type to be embedded in documents of another type. For example, a spreadsheet may be embedded in a word processing document. Under OLE, the embedded spreadsheet object may be activated and edited from the word processing window. In order to accomplish this task, OLE provides merged menus that provide commands from both the container (e.g., the word processor) and the server or object (e.g., the spreadsheet).
>
> An exemplary embodiment of the command bar architecture provides substantial advantages over prior art menu merging techniques. With command bars, application programs are no longer required to donate entire menus. Instead, an application may donate individual commands to the merged menus. These merged commands are organized in a way that is intuitive and user-friendly. In addition, merging between toolbar-like command bars is supported so that each button will be functional and will carry out the expected response. This results in

merged menus and toolbars that provide enhanced functionality, while also being user friendly.

[<u>Morcos</u>, column 13, lines 25-45]

Therefore, it is apparent that, in Morcos' system, individual commands may be donated *from a first user application to a second user application* for merging into a command bar.

B. Applicant's Claims

Morcos fails to teach several of Applicant's claim limitations. Applicant discusses some of those claim limitations in the following.

1. Claims 1, 4, 7, 8, and 18-20

Independent claim 1 provides as follows (emphasis added):

1. A method of providing a menu in relation to a document, the method comprising:

creating a document within a program;

identifying a predetermined behavior that can be used to modify documents opened within the program but that is not generally available for selection from a main menu of the program;

specifically associating the predetermined behavior with the created document; and

creating a menu item associated with the predetermined behavior that is configured for addition to the main menu of the program when the created document is opened within the program but that is not made generally available for all documents opened within the program, such that the predetermined behavior will be

available for selection from the main menu for the created document but not necessarily for other documents opened within the program.

As is described above, Morcos discloses merging menu items into a main menu of a first program (e.g., MS Word) when a document created in another program (e.g., MS Excel) is opened in the first program (MS Word). Although this process results in commands being merged into the first program when the document from the other program is opened in the first program, Morcos does not disclose merging menu items into a main menu of a first program *when a file that was created within that same program is opened*.

As is noted above, claim 1 requires "creating a document within a program", "specifically associating the predetermined behavior with the created document", and "creating a menu item associated with the predetermined behavior that is configured for addition to the main menu of the program when the created document is opened within the program". Morcos fails to disclose several aspects of those limitations. First, because Morcos describes embedding a file from one program into a document of a second program, Morcos fails to teach or suggest creating a menu item for addition to a main menu of a given program when a document *that was created in that same program* is opened within the program. In other words, Morcos, at best, discloses adding a menu item when documents from a different program are imported.

Furthermore, Applicant notes that Morcos says nothing about "specifically associating the predetermined behavior with the created document". Although Morcos describes merging menu items when a file from one program is embedded into a document of another type, *it is the second program (in which the document was created), not the document, that "donates" the menu items*. <u>Morcos</u>, column 13, lines

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36-39. Nothing in Morcos suggests that the menu items are specifically associated with the document. In other words, *any* document created in the second application would result in menu merging when opened in the first application.

In the Office Action, the Examiner argues that Morcos "clearly reads" on Applicant's claim limitations because Applicant's claim "only" recites "creating a menu item associated with the predetermined behavior that is configured for addition to the main menu of the program when the created document is opened with the program." In response, Applicant asserts that the Examiner is not considering Applicant's claim as a whole. In other words, the Examiner is considering each of Applicant's claim limitations individually without consideration of the other limitations. As is indicated above, Applicant claims the following:

> · creating a document within *a program*, and
>
> · creating a menu item . . . that is configured for addition to the main menu of *the program* when the created document is opened within *the program*

Clearly, Applicant is referencing a single program. We know this because after the term "program" is first introduced, *every* later instance of the term "program" is preceded by the definite article "the." Therefore, in accordance with the plain meaning of claim 1, Applicant describes: (i) creating a document in a program, and (ii) creating a new menu item for addition to a main menu *of the same program* when the document is *opened in that program*. Therefore, Morcos' disclosure of merging menu items when a document created in Excel is opened in Word clearly does not satisfy Applicant's claim limitations. In view of this, Morcos does not and cannot anticipate Applicant's claim 1.

2. Claims 9 and 21-23

Independent claim 9 provides as follows (emphasis added):

> 9.   A system for displaying a menu on a display device in relation to a particular document, the system being stored on a computer-readable medium, the system comprising:
>
> logic configured to *create a particular document within a program*;
>
> logic configured to *specifically associate a predetermined behavior with the particular document*;
>
> logic configured to create a menu fragment associated with the predetermined behavior, the menu fragment being configured for addition to a main menu of the program; and
>
> logic configured to *merge the menu fragment with the main menu when the particular document is opened* such that the predetermined behavior is made available for selection from the main menu of the program for the particular document but not necessarily for other documents opened within the program.

Morcos fails to teach or suggest each of "logic configured to create a particular document within a program", "logic configured to specifically associate a predetermined behavior with the particular document", and "logic configured to merge the menu fragment with the main menu when the particular document is opened", for at least the same reasons described above in relation to the discussion of claim 1. Applicant refers the Examiner back to that discussion.

3. Claims 12 and 14

Independent claim 12 provides as follows (emphasis added):

> 12. A method of providing a menu in relation to a particular *document that was created with and is running in a program*, the method comprising:
>
> receiving a user input;
>
> generating a command message in response to the user input, the command message comprising a command ID indicative of a predetermined process that corresponds to a selected menu item;
>
> determining if the command ID corresponds to a predetermined behavior that has been specifically associated with the particular document; and
>
> initiating a process represented by the predetermined behavior *where it is determined that the command ID corresponds to the predetermined behavior that has been specifically associated with the particular document.*

As a first matter, Morcos fails to teach or suggest "initiating a process represented by the predetermined behavior where it is determined that the command ID corresponds to the predetermined behavior that has been specifically associated with the particular document", for reasons described in the foregoing. Again, Morcos does not describe specifically associating predetermined behaviors with documents.

As a further point, Applicant notes that Morcos does not teach or suggest performing the various recited actions in relation to a document that was "created with and is running in a program". Again, Morcos only describes menu item merger in relation to documents from one program that are embedded into documents of another program.

4. Claim 24

Independent claim 24 provides as follows (emphasis added):

24. A system stored on a computer-readable medium, the system comprising:

logic configured to receive a user selection of a menu item;

logic configured to generate a command message in response to the user selection, the command message comprising a command ID indicative of a predetermined process that corresponds to the selected menu item;

logic configured to determine if the command ID corresponds to a predetermined behavior that has been specifically associated with a particular document; and

logic configured to initiate a process represented by the predetermined behavior *where it is determined that the command ID corresponds to the predetermined behavior that has been specifically associated with the particular document.*
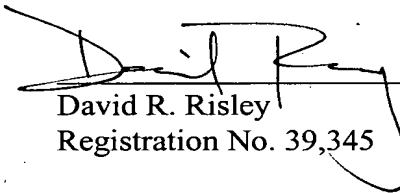
Regarding claim 24, Morcos does not teach or suggest "logic configured to initiate a process represented by the predetermined behavior where it is determined that the command ID corresponds to the predetermined behavior that has been specifically associated with the particular document", at least for reasons described in relation to claim 12.
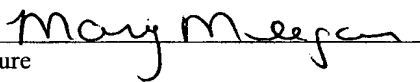
CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

7-25-05

Signature